REMARKS:

Claims 2-13 and 15-27 are currently pending in the application. Claims 2-4, 6, 7, 10, 13-17, 19, 20, 23, 26, and 27 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,329,619 to Page et al. ("*Page*") in view of U.S. Patent No. 6,523,022 B1 to Hobbs ("*Hobbs*"). Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over *Page* in view of *Hobbs* and in further view of U.S. Patent Application Publication No. 2003/0121000 A1 to Cooper et al. ("*Cooper*"). Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of *Hobbs* and in further view of U.S. Patent No. 6,381,579 to Gervais et al. ("*Gervais*"). Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Page* in view of *Hobbs* and in further view of U.S. Patent No. 5,926,636 to Lam et al. ("*Lam*"). Claims 16-25 stand objected to because of certain informalities.

By this Amendment, independent claims 13, 26, and 27 and dependent claims 3, 4, 11, 16, 17, and 24 have been amended to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 18-23 and 25 have been amended to correct certain dependencies. By making these amendments, the Applicants makes no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1-27. No new matter has been added.

CLAIM OBJECTION:

Claims 16-25 stand objected to because of certain informalities. Specifically, the Examiner indicates that claims 16-25 are shown dependent on canceled claim 14. The Applicants thank the Examiner for indicating that for the purpose of this Office Action, claims 16-25 are assumed to be dependent upon claim 26.

In response, the Applicants have amended claims 16-25 to correct the informalities and to indicate claims 16-25 depend upon claim 26.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2-4, 6, 7, 10, 13-17, 19, 20, 23, 26, and 27 stand rejected under 35 U.S.C. § 103(a) over *Page* in view of *Hobbs*. Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over *Page* in view of *Hobbs* and in further view of *Cooper*. Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of *Hobbs* and in further view of *Gervais*. Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Page* in view of *Hobbs* and in further view of *Lam*.

Although the Applicants believe claims 2-13 and 15-27 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 13, 26, and 27 and dependent claims 3, 4, 11, 16, 17, and 24 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 18-23 and 25 have been amended to correct certain dependencies. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that *Page* or *Hobbs* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2-4, 6, 7, 10, 13-17, 19, 20, 23, 26, and 27. The Applicants further submit that *Page*, *Hobbs*, or *Cooper* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5 or 18. The Applicants still further submit that *Page*, *Hobbs*, or Gervais either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 8 or 21. Furthermore, the Applicants respectfully submit that *Page*, *Hobbs*, or Lam either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 9, 11, 12, 22, 24, and 25. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of claims 2-4, 6, 7, 10, 13-17, 19, 20, 23, 26, and 27 under 35 U.S.C. § 103(a) over the proposed combination of *Page*, *Hobbs*, *Cooper*, *Gervais*, and *Lam*, either individually or in combination.

The Proposed *Page-Hobbs* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to amended independent claim 13, this claim recites:

A computer-implemented system for facilitating communication in a distributed network environment, the system comprising:

a request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system, operable to:

receive a network application program interface (API) request component from one or more clients within the distributed network environment, the *one or more clients located remote from the hub system*, the network API request component comprising a description of a system API method to be called and one or more parameters to be used in executing the system API method, the parameters having one of a plurality of acceptable native formats;

determine the native format of the parameters;

communicate the parameters in the native format to a selected one of a plurality of translators for translation of the parameters from the native format to an internal format, each translator being associated with a different native format; and

communicate the parameters in the internal format *to an application server to enable execution of the system API method according to the parameters*; and

the application server system, operable to receive the parameters from the request broker in the internal format, generate a return value reflecting execution of the system API method according to the parameters, and communicate the return value to the request broker in the internal format;

the request broker further operable to receive the return value from the application server system in the internal format, communicate the return value in the internal format to the selected translator for translation of the return value from the internal format to the native format, generate a network API reply component that comprises the description of the system API method that was called and the return value in the native format, and communicate the network API reply component to the one or more clients; and

a system firewall having a plurality of ports, the system maintaining at least one port of the system firewall open for communication with the one or more clients, *the one or more clients initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker, independent of any port of a client firewall being open for communication with the system*. (Emphasis Added).

Amended independent claims 26 and 27 recite similar limitations. *Page* or *Hobbs* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 13, 26, and 27.

The Applicants respectfully submit that *Page* has nothing to do with amended independent claim 13 limitations regarding a "***computer-implemented system for facilitating communication in a distributed network environment***" and in particular *Page* has nothing to do with amended independent claim 13 limitations regarding "***a request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system***, operable to: ***receive a network application program interface (API) request component from one or more clients within the distributed network environment***, the ***one or more clients located remote from the hub system***, the network API request component comprising a description of a system API method to be called and one or more parameters to be used in executing the system API method, the parameters having one of a plurality of acceptable native formats; ***determine the native format of the parameters***; ***communicate the parameters in the native format*** to a selected one of a plurality of translators for translation of the parameters from the native format to an internal format, each translator being associated with a different native format; and ***communicate the parameters*** in the internal format ***to an application server to enable execution of the system API method according to the parameters***. Rather *Page* discloses a service broker that manages service requests received from clients and servers. (Abstract). *Page* merely discloses a service request manager and does not disclose, suggest, or even hint at "***a request broker***".

In addition, it appears that the Examiner equates the "***request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system***" recited in amended independent claim 13 with the service broker disclosed in *Page*. (3 February 2006 Office Action, Page 3). However, the service broker disclosed in *Page* merely manages requests by participants for services and merely receives requests from a participant. (Column 4,

Line 37-41). In contrast, the *"request broker"* recited in amended independent claim 13 is *implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system*. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Page* and amended independent claim 13 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 13 from *Page*.

The Applicants further respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Page* fails to disclose the emphasized limitations noted above in amended independent claim 13. Specifically the Examiner acknowledges that *Page* fails to teach "*a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol web server*" within a hub system. (3 February 2006 Office Action, Pages 3-6). The Examiner further acknowledges that *Page* fails to teach "*a system firewall having a plurality of ports*, the system maintaining at least one port of the system firewall open for communication with the one or more clients, *the one or more clients initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker*, independent of any port of a client firewall being open for communication with the system." (3 February 2006 Office Action, Pages 3-6). However, the Examiner asserts that the cited portions of *Hobbs* disclose the acknowledged shortcomings in *Page*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Hobbs*.

The Applicants respectfully submit that *Hobbs* has nothing to do with amended independent claim 13 limitations regarding "*a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol web server within a hub system*" or "*a system firewall having a plurality of ports*, the system maintaining at least one port of the system firewall open for communication with the one or more clients, *the one or more clients initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker*, independent of any port of a client firewall

being open for communication with the system." Rather *Hobbs* discloses a method for information retrieval. (Abstract). In particular, it appears that the Examiner is equating *"a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol web server within a hub system"* recited in amended independent claim 13 with the Java Servlet API disclosed in *Hobbs*. (3 February 2006 Office Action, Pages 3-6). However, the Java Servlet API disclosed in *Hobbs* merely permits a server to establish channel security with a client and the server is not associated with *a web server within a hub system*. (Column 21, Line 66 through Column 22 Line 5). In contrast, the *"request broker"* recited in amended independent claim 13 is *implemented as a servlet* and is *"operating at a Secure Hypertext Transport Protocol web server"* which is *"within a hub system"*. In addition, the *"computer-implemented system for facilitating communication in a distributed network environment"* recited in amended independent claim 13 also comprises *"a system firewall having a plurality of ports"*. This *"system firewall"* recited in amended independent claim 13 provides for one or more clients within the distributed network environment and distributed remote from the hub system *"to communicate the network API request component to the request broker"* which is completely *"independent of any port of a client firewall being open for communication with the system."* Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Hobbs* and amended independent claim 13 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 13 from *Hobbs*.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Page* or *Hobbs*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate

the teachings of *Hobbs* into the Service Broker 14". (3 February 2006 Office Action, Pages 3-6). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Page* or *Hobbs*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "such that the access to servers may be restricted to particular clients, and registration of servers can be controlled as required by *Page*." (3 February 2006 Office Action, Pages 3-6). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does "the access to servers may be restricted to particular clients" relate to the "*system firewall having a plurality of ports*" as recited in amended independent claim 13 and to what extent does the Examiner purport that "the access to servers may be restricted to particular clients "*the one or more clients initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker*". In addition, how does controlling the "registration of servers" relate to "maintaining at least one port of the system firewall open for communication with the client" and to what extent does the Examiner purport that controlling the "registration of servers" applies to the subject Application. *The Applicants respectfully request the Examiner to point to the portions of Page or Hobbs which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.* In particular, the Applicants respectfully request the Examiner to point to the portions of *Page* or *Hobbs* which expressly state that "the access to servers may be restricted to particular clients" or that controlling the "registration of servers" accounts for "*the one or more clients initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker*". The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the *prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.* In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the *Examiner has not adequately supported the selection and combination of Page or Hobbs to render obvious the Applicants claimed invention.* The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of *Hobbs* into the Service Broker 14" and that "such that the access to servers may be restricted to particular clients, and registration of servers can be controlled as required by Page", *does not adequately address the issue of motivation to combine.* (3 February 2006 Office Action, Pages 3-6). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, *the Office Action fails to provide proper motivation for combining the teachings of Page or Hobbs*, either individually or in combination.

The Proposed *Page-Hobbs-Cooper* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 5 and 18

For example, with respect to dependent claim 5, this claim recites:

> The system of Claim 13, wherein:
> *the plurality of acceptable native formats* comprises Extensible Markup Language (XML), Electronic Data Interchange (EDI), and serialized object formats; and
> *the internal format comprises serialized object format, the parameters being converted into serialized object classes by the selected translator.* (Emphasis Added).

Dependent claim 18 recites similar limitations. *Page*, *Hobbs*, and *Cooper*, either individually or in combination, fail to disclose each and every limitation of dependent claims 5 and 18.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Page* and *Hobbs* fail to disclose the emphasized limitations in dependent claim 5. Specifically the Examiner acknowledges that *Page* and *Hobbs* fail to teach "***the plurality of acceptable native formats*** comprises Extensible Markup Language (XML), Electronic Data Interchange (EDI), and serialized object formats; and ***the internal format comprises serialized object format, the parameters being converted into serialized object classes by the selected translator***." (3 February 2006 Office Action, Page 11). However, the Examiner asserts that the cited portions of *Cooper* disclose the acknowledged shortcomings in *Page* and *Hobbs*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Cooper*.

The Applicants further submit that *Cooper* has nothing to do with dependent claim 5 limitations regarding "***the plurality of acceptable native formats***" or "***the internal format comprises serialized object format, the parameters being converted into serialized object classes by the selected translator***". Rather *Cooper* discloses a method to convert a programming language only through a static or dynamic process. (Abstract). *Cooper* does not disclose "***a request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system***", having a "***plurality of acceptable native formats***" or ***a translator for translation of the parameters from the native format to an internal format***. Thus, *Cooper* cannot provide "***a request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system***", having a "***plurality of acceptable native formats***" or ***a translator for translation of the parameters from the native format to an internal format***, since *Cooper* does not even provide for ***a request broker*** or even a translator for translation of the parameters from the native format to an internal format.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Page*, *Hobbs*, or *Cooper*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Cooper* into *Page's* service broker along with *Hobbs* teaching". (3 February 2006 Office Action, Page 11). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Page*, *Hobbs*, or *Cooper*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "such that it would be useful to have a method for adapting well-known APIs in some manner for use as a Web-based page description language." (3 February 2006 Office Action, Page 11). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does the Examiner arrive at the conclusion that "it would be useful to have a method for adapting well-known APIs in some manner for use as a Web-based page description language" and to what extent does the Examiner purport that "a method for adapting well-known APIs in some manner" applies to the subject Application. ***The Applicants respectfully request the Examiner to point to the portions of Page, Hobbs, or Cooper which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.*** In particular, the Applicants respectfully request the Examiner to point to the portions of *Page*, *Hobbs*, or *Cooper* which expressly state that "a method for adapting well-known APIs in some manner" accounts for or relates to "***a request broker, implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server within a hub system***", having a "***plurality of acceptable native formats***" or ***a translator for translation of the parameters from the native format to an internal format.***" The Applicants further submit that the Examiner is using the subject

Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the *prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art*. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the *Examiner has not adequately supported the selection and combination of Page, Hobbs, or Cooper to render obvious the Applicants claimed invention*. The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Cooper* into *Page's* service broker along with *Hobb's* teaching" and that "such that it would be useful to have a method for adapting well-known APIs in some manner for use as a Web-based page description language", *does not adequately address the issue of motivation to combine*. (3 February 2006 Office Action, Page 11). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, *the Office Action fails to provide proper motivation for combining the teachings of Page, Hobbs, or Cooper*, either individually or in combination.

The Proposed *Page-Hobbs-Gervais* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 8 and 21

For example, with respect to dependent claim 8, this claim recites:

> The system of Claim 13, wherein *the application server system supports one or more applications* comprising at least *a collaborative planning application operable to provide planning data for one or more clients within a supply chain*. (Emphasis Added).

Dependent claim 21 recites similar limitations. *Page*, *Hobbs*, and *Gervais*, either individually or in combination, fail to disclose each and every limitation of dependent claims 8 and 21.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Page* and *Hobbs* fail to disclose the emphasized limitations in dependent claim 8. Specifically the Examiner acknowledges that *Page* and *Hobbs* fail to teach "*the application server system supports one or more applications* comprising at least *a collaborative planning application operable to provide planning data for one or more clients within a supply chain.*" (3 February 2006 Office Action, Pages 12-13). However, the Examiner asserts that the cited portions of *Gervais* disclose the acknowledged shortcomings in *Page* and *Hobbs*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Gervais*.

The Applicants further submit that *Gervais* has nothing to do with dependent claim 8 limitations regarding "*the application server system supports one or more applications* comprising at least *a collaborative planning application operable to provide planning data for one or more clients within a supply chain.*" Rather *Gervais* discloses a portal that allows end users to access a server and view the users customized menu of applications. (Abstract). Thus, Gervais cannot provide "*the application server system supports one or more applications* comprising at least *a collaborative planning application operable to provide planning data for one or more clients within a supply chain*", since *Gervais* does not even provide for *an application server system within a hub system*, or even *a collaborative planning application remote from the hub system.*

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Page*, *Hobbs*, or *Gervais*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge

generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Gervais* into *Page's* service broker along with the teachings of *Hobbs*". (3 February 2006 Office Action, Pages 12-13). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Page*, *Hobbs*, or *Gervais*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "such that it provides a common infrastructure for application administration, security management, and directory use, which can help reduce information technology (IT) costs and speed solution deployment as taught by *Gervais*." (3 February 2006 Office Action, Pages 12-13). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does providing a "common infrastructure for application administration, security management, and directory use" directly "reduce information technology (IT) costs and speed solution deployment" and to what extent does the Examiner purport that providing a "common infrastructure for application administration, security management, and directory use" apply to the subject Application. *The Applicants respectfully request the Examiner to point to the portions of Page, Hobbs, or Gervais which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.* In particular, the Applicants respectfully request the Examiner to point to the portions of *Page*, *Hobbs*, or *Gervais* which expressly state that providing a "common infrastructure for application administration, security management, and directory use" even relates to "*the application server system supports one or more applications* comprising at least *a collaborative planning application operable to provide planning data for one or more clients within a supply chain.*" The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the *prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art*. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id*. at 1434-35. With respect to the subject Application, the *Examiner has not adequately supported the selection and combination of Page, Hobbs, or Gervais to render obvious the Applicants claimed invention*. The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Gervais* into *Page's* service broker along with the teachings of *Hobb's*" and that "such that it provides a common infrastructure for application administration, security management, and directory use, which can help reduce information technology (IT) costs and speed solution deployment as taught by *Gervais*", *does not adequately address the issue of motivation to combine*. (3 February 2006 Office Action, Pages 12-13). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id*. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, *the Office Action fails to provide proper motivation for combining the teachings of Page, Hobbs, or Gervais*, either individually or in combination.

The Proposed *Page-Hobbs-Lam* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 9, 11, 12, 22, 24, and 25

For example, with respect to dependent claims 9, 11, and 12, these claims recite:

9. The system of Claim 13, wherein the network API request component and network API reply component each comprise *a version identifier indicating the version of the network API request component and network API reply component being used*. (Emphasis Added).

11.   The system of Claim 13, wherein the network API reply comprises *a deprecation notice indicating to the one or more clients that the system API method that was called should not be further used.* (Emphasis Added).

12.   The system of Claim 13, wherein *the request broker is further operable to generate a network API exception component* based on an exception occurring in connection with execution of a second system API method called based on a network API request component received from a second client, the network API exception component *comprising a description of the second system API method, a description of the exception, and a deprecation notice indicating to the second client that the second system API method should not be further used.* (Emphasis Added).

Dependent claims 22, 24, and 25 recite similar limitations. *Page*, *Hobbs*, and *Lam*, either individually or in combination, fail to disclose each and every limitation of dependent claims 9, 11, 12, 22, 24, and 25.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Page* and *Hobbs* fail to disclose the emphasized limitations in dependent claims 9, 11, 12, 22, 24, and 25. Specifically the Examiner acknowledges that Page fails to teach "wherein the network API request component and network API reply component each comprise *a version identifier indicating the version of the network API request component and network API reply component being used*" and "wherein the network API reply comprises *a deprecation notice indicating to the one or more clients that the system API method that was called should not be further used*" and "wherein *the request broker is further operable to generate a network API exception component* based on an exception occurring in connection with execution of a second system API method called based on a network API request component received from a second client, the network API exception component comprising *a description of the second system API method, a description of the exception, and a deprecation notice indicating to the second client that the second system API method should not be further used.*" (3 February 2006 Office Action, Pages 13-15). However, the Examiner asserts that the cited portions of *Lam* disclose the acknowledged shortcomings in *Page* and *Hobbs*. The Applicants

respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Lam*.

The Applicants further submit that *Lam* has nothing to do with dependent claims 9, 11, and 12 limitations. Rather *Lam* discloses a component management application programming interface that provides a version of the server component management API and a reply indicating version incompatibility. (Abstract). *Lam* does not disclose, teach, or suggest: (1) "*a version identifier indicating the version of the network API request component and network API reply component being used*"; (2) "*a deprecation notice indicating to the one or more clients that the system API method that was called should not be further used*"; or (3) "*a description of the second system API method, a description of the exception, and a deprecation notice indicating to the second client that the second system API method should not be further used*", since *Lam* does not even provide for a version identifier indicating the version of the request component, a deprecation notice indicating the system application program interface method, or a request broker operable to generate an exception component.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Page*, *Hobbs*, or *Lam*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Lam* into *Page's* service broker [a]long with the teachings of *Hobbs*". (3 February 2006 Office Action, Pages 13-15). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Page*, *Hobbs*, or *Lam*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "such that the server component management application programming interface reads a field in the message to determine whether an

addressing format of the client computer is compatible with an addressing format of the server computer." (3 February 2006 Office Action, Pages 12-13). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does reading a field in the message "determine[s] whether an addressing format of the client computer is compatible with an addressing format of the server computer" and to what extent does the Examiner purport that reading a field in the message "determine[s] whether an addressing format of the client computer is compatible with an addressing format of the server computer" apply or even relate to (1) "*a version identifier indicating the version of the network API request component and network API reply component being used*"; (2) "*a deprecation notice indicating to the one or more clients that the system API method that was called should not be further used*"; or (3) "*a description of the second system API method, a description of the exception, and a deprecation notice indicating to the second client that the second system API method should not be further used.*" *The Applicants respectfully request the Examiner to point to the portions of Page, Hobbs, or Lam which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.* In particular, the Applicants respectfully request the Examiner to point to the portions of *Page, Hobbs,* or *Lam* which expressly state that reading a field in the message "determine[s] whether an addressing format of the client computer is compatible with an addressing format of the server computer" accounts for or even relates to the limitations recited in dependent claims 9, 11, and 12 of the subject Application. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the *prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee,* 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to

the subject Application, the ***Examiner has not adequately supported the selection and combination of Page, Hobbs, or Lam to render obvious the Applicants claimed invention***. The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the reference *Lam* into *Page's* service broker [a]long with the teachings of *Hobbs*" and "such that the server component management application programming interface reads a field in the message to determine whether an addressing format of the client computer is compatible with an addressing format of the server computer", ***does not adequately address the issue of motivation to combine***. (3 February 2006 Office Action, Pages 13-15). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Page, Hobbs, or Lam***, either individually or in combination.

The Applicants Claims are Patentable over the Proposed *Page-Hobbs-Cooper-Gervais-Lam* Combination

The Applicants respectfully submit that amended independent claims 13, 26, and 27 are considered patentably distinguishable over the proposed combination of *Page*, *Hobbs*, *Cooper*, *Gervais*, and *Lam*. This being the case, amended independent claims 13, 26, and 27 are considered patentably distinguishable over the proposed combination of *Page*, *Hobbs*, *Cooper*, *Gervais*, and *Lam*.

With respect to dependent claims 2-12 and 15-25: claims 2-12 depend from amended independent claim 13 and claims 15-25 depend from amended independent claim 26. As mentioned above, each of amended independent claims 13 and 26 are considered patentably distinguishable over the proposed combination of *Page*, *Hobbs*, *Cooper*, *Gervais*, and *Lam*. Thus, dependent claims 2-12 and 15-25 are considered to be in condition for allowance for at least the reasons of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 2-13 and 15-27 are not rendered obvious by the proposed combination of *Page, Hobbs, Cooper, Gervais,* and *Lam.* The Applicants further submit that claims 2-13 and 15-27 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2-13 and 15-27 under 35 U.S.C. § 103(a) be reconsidered and that claims 2-13 and 15-27 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure***. *In re Vaeck,* 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka,* 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.,* 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills,* 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have

suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

4/11/06

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